

REMARKS

In the Office Action, the Examiner rejected claims 1-24. By this paper, no claims have been amended, cancelled, or added. Accordingly, claims 1-24 still remain pending in the application. The Applicant respectfully requests reconsideration of the above-identified application in view of the remarks set forth below.

Interview Summary

In accordance with 37 C.F.R. § 1.133 and M.P.E.P. § 713.04, the Applicant presents the following summary of a telephonic interview between the Examiner and the Applicant's Attorney, David M. Hoffman, Reg. No. 54,174. The interview was conducted on February 14, 2006. The interview was initiated by the Applicant's Attorney to discuss the pending Section 102 rejection and the Clark reference (U.S. Patent No. 6,233,634) as it relates to the independent claims in the present application. After discussion of the Clark reference and the pending claims, the Examiner indicated that presentation of the remarks below would likely overcome the Section 102 rejection based on the Clark reference.

Rejections Under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-2, 6-10, 14-18, and 20-22 under 35 U.S.C. § 102(e) as being anticipated by Clark et al. (U.S. Patent No. 6,233,634, hereafter "the Clark reference"). The Applicant respectfully traverses this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir.1990). That is, the prior art reference must show the *identical invention* “*in as complete detail as contained in the ... claim*” to support an anticipation rejection. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Thus, for anticipation, the cited reference must not only disclose all of the recited features but must also disclose the *part-to-part relationships* between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir.1984). Accordingly, the Applicant need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. *A strict correspondence* between the claimed language and the cited reference must be established for a valid anticipation rejection.

Moreover, the Applicant submits that, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent* with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. § 2111 (describing the standards for claim interpretation during prosecution). Indeed, the *specification* is “the primary basis for construing the claims.” *See Phillips v. AWH Corp.*, 75 U.S.P.Q.2d 1321 (Fed. Cir. July 12, 2005) (citations omitted). It

is usually dispositive. *See id.* Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); *see also* M.P.E.P. § 2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. *See Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); *see also* M.P.E.P. § 2111.01. In summary, an Examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art would reasonably interpret the claim in view of the specification. *See In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

Deficiencies of the Rejection

As stated above, the Examiner rejected claims 1-2, 6-10, 14-18, and 20-22 under 35 U.S.C. § 102(e) as being anticipated by the Clark reference. The Applicant respectfully traverses these rejections. In particular, the Applicant asserts that the Clark reference does not anticipate independent claims 1, 9, 17, and 21, or the claims that depend therefrom. Independent claims 1 and 9 each recite “a FIFO that is adapted to store data snooped *from the communication bus*” and an embedded controller “adapted to take *control of the communication bus*.” (Emphasis added). Further, independent claims 1 and 9 recite “an embedded bus master that is ... adapted *to take control* of the communication bus responsive to a signal that the FIFO *has become filled to a predetermined level*.” (Emphasis added). Independent claim 17 recites a method comprising “snooping a communication bus” and “*preventing further transfers* of data on the communication bus responsive to the act of determining if the storage device is *filled to a predetermined level*.” (Emphasis added). Independent claim 21 recites “a queue...configured to

store data snooped from the bus” and a “bus master configured *to throttle a flow* of snooped data from the bus to the queue *if a predetermined amount of data* is stored in the queue.” (Emphasis added).

In sharp contrast, the Clark reference is directed towards a “server controller [that] snoops display data written from the host CPU to the video controller and mirrors the display data on buffers within the server controller.” Clark, Abstract, lines 20-24. This server controller 26 includes buffers 54 and 56, which contain screen changes snooped from the expansion (EISA) bus. *See* Clark, col. 9, lines 59-67; *see also* Figs. 3 and 5. The Applicant respectfully asserts, however, that contrary to the Examiner’s assertion, the server controller 26 of the Clark reference does not anticipate the above-recited claim features.

As described above, claims 1 and 9 recite “a FIFO that is adapted to store data snooped *from the communication bus*” and an embedded controller “adapted to take *control of the communication bus*.” (Emphasis added). In rejecting the present claims, the Examiner first correlated *the expansion bus* of the Clark reference with the “communication bus” recited in the claims. *See* Final Office Action, page 2. However, when the Examiner reached the “adapted to take *control of the communication bus*” limitation, the Examiner (perhaps realizing that the Clark reference does not disclose taking control of the expansion bus) changed the rejection to rely on the server controller’s control of *a different bus* (i.e., the controller bus) to disclose the control features. *See* Final Office Action, pages 7-8 (stating that “Clark teaches [that] ‘Control logic [of the server controller 26] must ensure that it will be able to obtain ownership of the controller

bus.”(emphasis in original)). Stated another way, claims 1 and 9 recite storing “data snooped from the communication bus” and taking “control of the communication bus” (emphasis added); whereas the Clark reference discloses a server controller 26 that is configured to snoop one bus (the expansion bus) and control *another* bus (the controller bus). See Clark, col. 9, lines 46-48 and col. 23, lines 47-52. In the rejection, however, the Examiner blurred together these two features of the Clark reference together to arrive at the above-recited claim features. The Applicant respectfully asserts that this blurring by the Examiner was improper and resulted in a rejection that is clearly not supported by the actual teachings of the Clark reference. Accordingly, for at least this reason, the Applicant respectfully asserts that the Clark reference cannot anticipate the above-recited claim features.

Moreover, the discussion above notwithstanding, in the Examiner’s interview conducted on February 14, 2006, the Examiner conceded that the Clark reference did not disclose taking control of the expansion bus *responsive to a signal that the FIFO has become filled to a predetermined level*, as recited in independent claims 1 and 9 or the other above-described features of claims 17 and 21. Accordingly, for this additional reason, the Applicant respectfully asserts that the Clark reference cannot anticipate the above-recited subject matter. As such, the Applicant respectfully requests that the pending Section 102 rejection based on the Clark reference be withdrawn.

Rejections Under 35 U.S.C. § 103

The Examiner also rejected claims 3-5, 11-13, 19, and 23-24 under 35 U.S.C. § 103(a) as being unpatentable by the Clark reference in view of Brown (U.S. Patent No. 6,728,808 B1, hereafter "the Brown reference"). However, the Applicant respectfully asserts that the Examiner has not established a *prima facie* case of obviousness with regard to claims 3-5, 11-13, 19, and 23-24. As stated above, the Clark reference clearly does not disclose those claim features attributed to it by the Examiner. In view of this deficiency, the Examiner's Section 103 rejection of claims 3-5, 11-13, 19, and 23-24, which are based upon the Examiner's mistaken interpretation of the Clark reference, cannot establish a *prima facie* case of obviousness. As such, the Applicant respectfully requests withdrawal of the Section 103 rejections of claims 3-5, 11-13, 19, and 23-24.

Conclusion

The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned Attorney at the telephone number indicated below.

Respectfully submitted,

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